

Application No.: 10/508,942
Filing Date: October 01, 2004

REMARKS

Applicant thanks the Examiner for her courtesy extended to the Applicant's representative. In the Final Office Action, the Examiner rejected claim 25 under 35 U.S.C. 112, 2nd paragraph; rejected claims 18-24, 26, 30-35, 37-39, and 42 under 35 U.S.C. 103(a) over U.S. Patent No. 6,330,544 to Walker ("Walker") in view of U.S. Patent No. 6,006,205 to Loeb et al. ("Loeb"), further in view of U.S. Patent Application Publication No. 2003/0155416 to Macklin et al. and further in view of U.S. Patent No. 7,155,411 to Blinn et al. ("Blinn"); rejected claims 25 and 41 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of The Sal Anthony Website Policy on Gift Certificates ("Sal Anthony"); rejected claims 29 and 40 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of Official Notice; rejected claims 27 and 36 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of U.S. Patent Application Publication No. 2003/0195840 to Xu ("Xu"); rejected claim 28 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of Official Notice.

By this Amendment, Applicant respectfully traverses these rejections. Claims 25, 32 and 41 have been amended. Claims 37-40 have been canceled. Claims 18-36, 41 and 42 are currently pending.

Comments on the Examiner's Official Notice

In the Office Action, the Examiner alleges that Applicant did not properly traverse the taking of Official Notice with respect to claims 28-29, 36, and 40. Applicant respectfully disagrees and reiterates the challenge to the Examiner's Official Notice.

In rejecting these claims, the Examiner took Official Notice on various teachings. Respectfully, Applicant specifically objects to these assertions of Official Notice and disagrees that such features are common knowledge within what can be taken as Official Notice. In light of Applicant's specific challenge, the Applicant respectfully submit that the Examiner must now produce documentary evidence that supports the assertions of Official Notice. See MPEP 2144.03(C). Therefore, the Applicant maintains the challenge to all of the Examiner's assertions of Official Notice and that no admission of prior art has been made by the Applicant.

Application No.: 10/508,942
Filing Date: October 01, 2004

Rejection of Claim 25 under 35 U.S.C. 112, 2nd Paragraph

The Office Action rejected Claim 25 under 35 U.S.C. 112, 2nd paragraph. Applicant has reviewed Claim 25 and, where appropriate, amended the claim to correct the informality noted by the Examiner. Therefore, reconsideration and withdrawal of these rejections is requested.

Rejection of Claims 18-24, 26, 30-31, 37-39 and 42

The Office Action rejected Claims 18-24, 26, 30-35, 37-39, and 42 under 35 U.S.C. 103(a) over Walker in view of Loeb and further in view of Macklin and Blinn. The Applicant traverses this rejection. Claims 37-40 have been canceled, and accordingly the rejection is moot.

Applicant submits Claim 18 and its dependent claims are patentable over the references. For the convenience of the Examiner, Claim 18 is reproduced.

18. A method of processing a gift certificate within a credit card account issued by a financial institution, the method comprising:

receiving, by a computer system of the financial institution, a request for registering a gift certificate in a pre-existing credit card account such that a monetary value of the gift certificate is established as a gift certificate use limit within the pre-existing credit card account;

subsequent to receiving the request, establishing, by the computer system, a gift certificate use limit in an amount of the monetary value within the credit card account;

approving a plurality of transactions using at least one credit card associated with the credit card account, the plurality of transactions totaling a total transaction amount; and

subsequent to approving at least some of the transactions, computing, by the computer system, a total charge amount to be charged to an owner of the credit card account for the plurality of transactions, wherein the total charge amount is computed based on applying at least some of the gift certificate use limit to charges associated with one or more transactions approved for the credit card account.

The Examiner correctly acknowledges that neither Walker nor Loeb teaches the claimed feature of “receiving, by a computer system of the financial institution, a request for registering a gift certificate in a pre-existing credit card account such that a monetary value of the gift certificate is established as a gift certificate use limit within the pre-existing credit card account.”

To remedy this deficiency of Walker and Loeb, the Examiner relies on Macklin and Blinn.

Application No.: 10/508,942
Filing Date: October 01, 2004

First, the Examiner relied on Macklin for its teaching of sub-accounts under one primary account. Noting that the combination of Walker, Loeb and Macklin is still deficient, the Examiner then referred to Blinn's teaching of a gift certificate as a sub-account of an electronic wallet and asserted that it would have been obvious to one skilled in the art to combine teachings of Walker, Loeb, Macklin and Blinn to reach the claimed invention.

Applicant respectfully submits that Macklin and Blinn in combination do not teach the claimed feature of "receiving, by a computer system of the financial institution, a request for registering a gift certificate in a pre-existing credit card account such that a monetary value of the gift certificate is established as a gift certificate use limit within the pre-existing credit card account." More specifically, the combination of Macklin's teaching of multiple sub-accounts and Blinn's teaching of a gift certificate as a sub-account of an electronic wallet does not provide the concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account. The concept (1) is presented in the claimed step of "receiving ... a request ..." The concept (2) is presented in the claimed steps of "approving a plurality of transactions ..." and "computing a total charge ..."

Applicant notes that Blinn's gift certificate sub-account can be established within an electronic wallet, but NOT within a pre-existing CREDIT CARD account. More importantly, the money placed in Blinn's gift certificate sub-account would NOT be used like a CREDIT within a CREDIT CARD account, although it may be used like a balance within a gift certificate. Therefore, Blinn's teaching of a gift certificate as a sub-account of an electronic wallet is by far less than the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account. While Applicant notes that Macklin teaches sub-accounts under one primary account, the combination of Macklin and Blinn does not provide the foregoing concepts presented in Claim 18.

The conclusion of obviousness using hindsight reasoning is impermissible when the reasoning uses knowledge gleaned only from applicant's own disclosure. The M.P.E.P. states at Section 2145 X. A. that "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was

Application No.: 10/508,942
Filing Date: October 01, 2004

within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)."

None of the four references teach or are concerned about the claimed concepts of (1) establishing a gift certificate use limit (2) for using it like a credit in a credit card account. In view of the complete absence of these concepts in the prior art, Applicant submits that the outstanding rejection appears to use Applicant's own disclosure of these concepts and features in concluding that Claim 18 is obvious. This is a result of *impermissible hindsight*. For at least this reason, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim 18. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 18 and its dependent claims.

Rejection of Claims 25 and 41

The Office Action rejected Claims 25 and 41 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of Sal Anthony. Applicant respectfully traverses this rejection.

The Examiner correctly acknowledges that Walker, Loeb, Macklin, and Blinn fail to teach or suggest all the features of Claims 25 and 41. However, the Examiner relies on Sal Anthony to cure the deficiencies of Walker, Loeb, Macklin, and Blinn.

Claims 25 and 41 depend from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, the combination of Walker, Loeb, Macklin and Blinn fails to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

The Examiner relied on Sal Anthony only to provide the features of Claims 25 and 41. However, Sal Anthony does not remedy the foregoing failure of Walker, Loeb, Macklin, and Blinn. Accordingly, even if Walker, Loeb, Blinn and Sal Anthony are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectfully submits reconsideration and withdrawal of the rejection of Claims 25 and 41.

Application No.: 10/508,942
Filing Date: October 01, 2004

Rejection of Claims 29 and 40

In the Office Action, the Examiner rejected claims 29 and 40 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of Official Notice. Applicant respectfully traverses this rejection.

The Examiner correctly acknowledges that Walker, Loeb, Macklin, and Blinn fail to teach or suggest all the features of claims 29 and 40. However, the Examiner takes Official Notice to cure the deficiencies of Walker, Loeb, Macklin, and Blinn. As discussed above, Applicant respectfully submits that the Examiner's assertion of Official Notice was improper.

Claims 29 and 40 depend from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, the combination of Walker, Loeb, Macklin and Blinn fails to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

Even assuming *arguendo* that the Examiner is correct regarding Official Notice, the accreted Official Notice does not remedy the failure of Walker, Loeb, Macklin, and Blinn. Accordingly, the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectfully submits reconsideration and withdrawal of the rejection of Claims 29 and 40.

Rejection of Claim 27

In the Office Action, the Examiner rejected Claim under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn and further in view of U.S. Patent Application Publication No. 2003/0195840 to Xu ("Xu"). Applicant respectfully traverses this rejection.

The Examiner correctly acknowledges that Walker, Loeb, Macklin, and Blinn fail to teach or suggest all the features of Claim 27. However, the Examiner relies upon Xu to cure the deficiencies of Walker, Loeb, Macklin, and Blinn.

Claim 27 depends from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, the combination of Walker, Loeb, Macklin and Blinn fails to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts of

Application No.: 10/508,942
Filing Date: October 01, 2004

(1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

The Examiner relied on Xu only to provide the features of Claim 27. However, Xu does not remedy the foregoing failure of Walker, Loeb, Macklin, and Blinn. Accordingly, even if Walker, Loeb, Macklin, Blinn and Xu are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectfully submits reconsideration and withdrawal of the rejection of Claim 27.

Rejection of Claim 28

In the Office Action, the Examiner rejected claim 28 under 35 U.S.C. 103(a) over Walker in view of Loeb, Macklin, and Blinn, Xu, and further in view of Official Notice. Applicant respectfully traverses this rejection.

The Examiner correctly acknowledges that Walker, Loeb, Macklin, Blinn, and Xu fail to teach or suggest all the features of claim 28. However, the Examiner takes Official Notice to cure the deficiencies of Walker, Loeb, Macklin, Blinn, and Xu. As discussed above, Applicant respectfully submits that the Examiner's assertion of Official Notice was improper.

Claim 28 depends from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, the combination of Walker, Loeb, Macklin and Blinn fails to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

Even assuming *arguendo* that the Examiner is correct regarding Official Notice, the accreted Official Notice does not remedy the failure of Walker, Loeb, Macklin, and Blinn. Accordingly, the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectfully submits reconsideration and withdrawal of the rejection of Claim 28.

Rejection of Claim 32

The Office Action rejected Claim 32 under 35 U.S.C. 103(a) over Loeb in view of

Application No.: 10/508,942
Filing Date: October 01, 2004

Macklin and Blinn. Applicant traverses this rejection and submits Claim 32 is patentable over the references. For the convenience of the Examiner, Claim 32 is reproduced.

32. A method of processing a gift certificate by a financial institution, the method comprising:

receiving, by a computer system of the financial institution, information identifying a pre-existing credit card account at the financial institution, wherein the account is associated with at least one card for use in purchase transactions;

receiving, by the computer system, a request for approval of using a gift certificate within the account, wherein the gift certificate has been issued by a gift certificate issuer and has a monetary value; and

upon approval of the request, creating, by the computer system, a gift certificate use limit within the pre-existing account such that the monetary value of the gift certificate is made available through the at least one card for one or more purchase transactions without regard to whether at least part of the transactions is made with the gift certificate issuer or merchants affiliated with the gift certificate issuer.

The Examiner correctly acknowledges that Loeb fails to teach the claimed feature of “receiving, by the computer system, a request for approval of using a gift certificate within the [pre-existing credit card] account, wherein the gift certificate has been issued by a gift certificate issuer and has a monetary value.”

To remedy this deficiency of Loeb, the Examiner relies on Macklin and Blinn. First, the Examiner relied on Macklin for its teaching of sub-accounts under one primary account. Noting that the combination of Walker, Loeb and Macklin is still deficient, the Examiner then referred to Blinn’s teaching of a gift certificate as a sub-account of an electronic wallet and asserted that it would have been obvious to one skilled in the art to combine teachings of Walker, Loeb, Macklin and Blinn to reach the claimed invention. The Examiner asserted that Blinn discloses “upon approval of the request, creating, by the computer system, a gift certificate use limit within the pre-existing account such that the monetary value of the gift certificate is made available through the at least one card for one or more purchase transactions without regard to whether at least part of the transactions is made with the gift certificate issuer or merchants affiliated with the gift certificate issuer.”

Applicant respectfully submits that Macklin and Blinn in combination teaches neither “receiving, by the computer system, a request for approval of using a gift certificate within the [pre-existing credit card] account” nor “creating, by the computer system, a gift certificate use

Application No.: 10/508,942
Filing Date: October 01, 2004

limit within the pre-existing account such that the monetary value of the gift certificate is made available through the at least one card for one or more purchase transactions without regard to whether at least part of the transactions is made with the gift certificate issuer or merchants affiliated with the gift certificate issuer.” More specifically, the combination of Macklin’s teaching of multiple sub-accounts and Blinn’s teaching of a gift certificate as a sub-account of an electronic wallet does not provide the concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

Applicant notes that Blinn’s gift certificate sub-account can be established within an electronic wallet, but NOT within a pre-existing CREDIT CARD account. More importantly, the money placed in Blinn’s gift certificate sub-account would NOT be used like a CREDIT within a CREDIT CARD account, although it may be used like a balance within a gift certificate. Therefore, Blinn’s teaching of a gift certificate as a sub-account of an electronic wallet is by far less than the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account. While Applicant notes that Macklin teaches sub-accounts under one primary account, the combination of Macklin and Blinn does not provide the foregoing concepts presented in Claim 32.

The conclusion of obviousness using hindsight reasoning is impermissible when the reasoning uses knowledge gleaned only from applicant’s own disclosure. The M.P.E.P. states at Section 2145 X. A. that “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.” *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).”

None of the four references teach or are concerned about the claimed concepts of (1) establishing a gift certificate use limit (2) for using it like a credit in a credit card account. In view of the complete absence of these concepts in the prior art, Applicant submits that the outstanding rejection appears to use Applicant’s own disclosure of these concepts and features in concluding that Claim 32 is obvious. This is a result of *impermissible hindsight*. For at least this reason,

Application No.: 10/508,942
Filing Date: October 01, 2004

Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim 32. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 32.

Rejection of Claims 33-35

The Office Action rejected Claims 33-35 under 35 U.S.C. 103(a) over Loeb in view of Macklin and Blinn, and further in view of Walker. Applicant respectfully traverses this rejection.

The Examiner correctly acknowledges that Loeb, Macklin, and Blinn fail to teach or suggest all the features of Claims 33-35. However, the Examiner relies on Walker to cure the deficiencies of Loeb, Macklin, and Blinn.

Claims 33-35 depend from Claim 32, and therefore are patentable if Claim 32 is patentable. As discussed above, the combination of Loeb, Macklin and Blinn fails to establish a *prima facie* case of obviousness of Claim 32 for their complete failure of the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

Walker was relied on to provide the features of Claims 33-35 only. However, Walker does not remedy the foregoing failure of Loeb, Macklin, and Blinn. Accordingly, even if Loeb, Macklin, Blinn and Walker are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 32. In view of the patentability of Claim 32, Applicant respectfully submits reconsideration and withdrawal of the rejection of Claims 33-35.

Rejection of Claim 36

In the Office Action, the Examiner rejected Claim under 35 U.S.C. 103(a) over Loeb in view of Macklin, and Blinn and further in view of Xu. Applicant respectfully traverses this rejection.

The Examiner correctly acknowledges that Loeb, Macklin, and Blinn fail to teach or suggest all the features of Claim 36. However, the Examiner relies upon Xu to cure the deficiencies of Walker, Loeb, Macklin, and Blinn.

Claim 36 depends from Claim 32, and therefore are patentable if Claim 32 is patentable. As discussed above, the combination of Loeb, Macklin and Blinn fails to establish a *prima facie*

Application No.: 10/508,942
Filing Date: October 01, 2004

case of obviousness of Claim 32 for their complete failure of the claimed concepts of (1) establishing a gift certificate use limit within a credit card account and (2) allowing the gift certificate use limit to be used like a credit within a credit card account.

The Examiner relied on Xu only to provide the features of Claim 36. However, Xu does not remedy the foregoing failure of Loeb, Macklin, and Blinn. Accordingly, even if Walker, Loeb, Macklin, Blinn and Xu are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 32. In view of the patentability of Claim 32, Applicant respectfully submits reconsideration and withdrawal of the rejection of Claim 36.

Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompts allowance of the claims.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Application No.: 10/508,942
Filing Date: October 01, 2004

CONCLUSION

In view of Applicant' amendments to the claims and the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Should the Examiner have any remaining concerns, which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 25, 2009

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